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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/786,336	06/13/2001	Garri Kimovich Kasparov	204271US2PCT	5069
22850	7590	05/28/2004	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				MARKS, CHRISTINA M
			ART UNIT	PAPER NUMBER
			3713	

DATE MAILED: 05/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/786,336	KASPAROV ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	C. Marks	3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 01 March 2004.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 36-54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 36-54 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                     | Paper No(s)/Mail Date. _____ .  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____ .                                  |

## DETAILED ACTION

### ***Specification***

The specification is objected to for the multiple inclusions of <> around words (for example see pages 1, 7, 11, 14, among others). Applicant is required properly correct the inclusion of <> in response to this Office Action. As per the Applicant's arguments that the inclusion of such symbols is not improper because the Examiner has failed to indicate a basis for this objection, the Examiner points the Applicant to review 35 U.S.C. §112 which states: "The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same." The inclusion of <> defies this requirement as it does not define a full, clear, concise, and exact terms as to what they mean in their context. A skilled artisan would not understand if they create a special function for the words they surround or somehow imply the meaning is changed in a certain way, thus their inclusion results in the specification not being clear, concise or exact as a skilled artisan would not understand how they are related or affect the words they surround.

### ***Drawings***

The objection to the drawings has been withdrawn due to the amendment filed removing the language, which was not adequately illustrated.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 47-50 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Regarding claims 47-50, though a game area is mentioned in the specification, there is not adequate support for forming a game area. The step of forming a game area is not enabled in such a manner to allow one of ordinary skill in the art to make or use the invention.

Claims 44-54 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claim 44, it does not appear to be disclosed in the specification that the first count comprises a code number of a count

Regarding claim 45 and those dependent therefrom, it does not appear to be disclosed in the specification that the first count comprises storing information relating to a drawing version wherein a drawing version comprises at least one of an event code or monetary stake.

Regarding claim 46, it does not appear to be disclosed in the specification that the device checks the correctness of the information and if the information is incorrect, generating a signal for prohibiting recording of said incorrect information in memory.

Regarding claim 49, it does not appear to be disclosed in the specification that the game area corresponds to a roulette game.

Regarding claim 50, it does not appear to be disclosed in the specification that the game area can correspond to a code of a lottery event.

Regarding claim 51, it does not appear to be disclosed in the specification that true information and conditions for determining a win can be input into the memory device. Likewise, true information and conditions does not appear to be disclosed or defined.

Claims 44-54 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Furthermore, due to the new matter regarding the above named limitations, these limitations are also rejected under 35 U.S.C. 112, first paragraph, as non-enabling as they are not originally defined in the specification; therefore, the usage of the terms and limitations is not done so in a manner that would enable one of ordinary skill in the art to make or use the invention.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 36-43 and 44-54 (as best possibly understood) are rejected under 35 U.S.C. 103(a) as being unpatentable over Fascenda et al. (US Patent No. 4,592,546).

Fascenda et al. disclose a method of conducting a lottery wherein a user has a portable memory device (FIG 1) with the memory device having an input (FIG 1, reference 12) and output (FIG 1, reference 16) unit, a timer (Column 3, lines 7-8), and a memory configured to store the timing data (Column 3, lines 10-20). The device is in communication with a data collection unit such that the timing data stored in the memory device can be read by the collection computer (Column 3, lines 15-20). This data is used to determine the time in which the user input information into the device (Column 3, lines 53-58).

Fascenda et al. also disclose the use of a count associated with a number of counters and serve as real time clocks to keep time data (Column 3, lines 10-20). The count outputs data and starts at a first time prior to the user inputting lottery information. This information is associated with a first event count representing the time lottery information input by the user was recorded. The count would be output at the time the user enters the information in order to properly account for the time in which the input occurred. Fascenda et al. also disclose a second time associated with a second count to make sure the first count was input before the deadline (Columns 5, lines 18-60). In this manner, the device of Fascenda et al. is storing count data relating to the input of the user and the time in which the user input the information. The time of entry and time of actual event is stored (Column 3, lines 53-58). As a number of inputs are used, it is notoriously well known in the art that frequencies and periods could thus be

garnished. The same feature applies to second and subsequent times including the time in which the play actually happened throughout the life of the event (Column 1, lines 62-64).

Fascenda et al. does not discloses that the time the user entered the lottery information is determined via a frequency and a period and the first time counts associated with the timer and then using the data collection computer to store this timing data. However, the manner in which the time is recorded is a design choice with alternatives known in the art and are thus obvious. A skilled artisan is more than efficient in recognizing the number of ways in which timing data can be generated and read. It would be obvious to a skilled artisan that instead of comparing two recorded times that the times could be derived based on a frequency or period and then compared. The process is essentially the same as all time data has by its own nature a frequency and a period and adding the step of determining the time from this data is just a known feature in the art that was merely omitted by the Fascenda et al. disclosure. Fascenda et al. does not go into clocking details as to how the time is recorded and obtained. A skilled artisan though understands the intent of Fascenda et al. is to make sure the entry occurred before the event and to use a different known timing method would be obvious to a skilled artisan. Time is easily derived from period and frequency and using one means of establishing when an event was recorded over another would merely be representative of a design choice for one of ordinary skill in the art. The artisan would be motivated to use one over another based on their own wants, needs, and desires for their systems specifications and the decision to actually use a different known timing method over the method disclosed by Fascenda et al. would merely be representative of a design change by an artisan to best accommodate the timing needs for their own system and is merely representative an obvious change in choosing one known timing method over another.

Regarding claims 37-43, as disclosed above, using different timing calculations would have been obvious to the Fascenda et al. system. Thus, it would be apparent to a skilled artisan to use the data stored in relation to the timing of events as disclosed by Fascenda et al. to make further computations involving the timing, frequency, period, and error associated with these calculations, as such computations involving establishing other data relating to timing from variables already acquired is notoriously well known in the art and thus would have been obvious to one of ordinary skill in the art at the time of invention.

Regarding claim 44, as best understood, the timers have counters that store verification codes associated with the timer in order to help prevent cheating (Abstract).

Regarding claim 45, as best understood, Fascenda et al. do not explicitly disclose storing information relating to the drawing version; however, each prediction is in essence its own drawing and information event codes according to the play that actually happened are stored in order to provide comparison to user input (Column 4, lines 1-15).

Regarding claim 46, as best understood, Fascenda et al. discloses checking the correctness of the information in the matter of checking to make sure it was entered within the correct time period. If the information was not entered within the correct time period and thus is incorrect, it will not be recorded or entered into the system (Column 3, lines 53-65).

Regarding claim 47, as best understood, the method of Fascenda et al. is related to a game area corresponding to a lottery event, as players wager to on a selection of a plurality of possibilities that can occur in the future (Column 2, lines 57-58).

Regarding claims 48 and 49, as best understood, the type of lottery game used in respect to Bingo or Roulette would have been obvious to one of ordinary skill in the art as both are notoriously well known in the art as games wherein the participant can predict a future

variable of an event up to a time before the event actually occurs, which is the same format disclosed by Fascenda et al.

Regarding claim 50, as best understood, Fascenda et al. discloses that many predictions can be made throughout the life of the event (Column 1, lines 59-62). It would be axiomatic to the method when the game is started a code identifying such a start time is created. This code is also disclosed in the form of a snap time that indicates the start of each prediction part of the lottery event (Column 3, lines 50-60).

Regarding claim 51, as best understood, the user can input what they believe to be true information and this information is compared to the actual true information in order to determine a win (Column 4, lines 1-3).

Regarding claim 52, as best understood, the system of Fascenda et al. discloses an information source linking participants to a lottery over a communication channel (FIG 1). This portable memory source includes an input (FIG 1, reference 12), an output (FIG 1, reference 16), a timer, a memory (FIG 2, reference 26), a control unit (FIG 2, reference 23). The system also includes a data collection computer that has an I/O unit (Column 3, lines 25-40). The system also includes a time measuring means (Column 3, lines 10-20) connected to the real time timer of the portable device (Column 3, lines 10-20) with an input and output (Column 3, lines 25-42).

It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitation *Ex parte Masham*, 2 USPQ2d 1647 (1987). A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the

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intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Thus, in the structural claim dictated by claims 52-54 the Fascenda et al. lottery system is capable of being used in the disclosed manner which would not result in a structural difference, only a difference of a software program executed by the respective processors. Hence the recitation that the device be employed in a specific manner regarding the actions of the structure does not differentiate the claimed apparatus from the Fascenda et al. apparatus, which satisfies the claimed structural limitation. Additionally, the Applicant is invited to review MPEP §2114 R-1 which states: MANNER OF OPERATING THE DEVICE DOES NOT DIFFERENTIATE APPARATUS CLAIM FROM THE PRIOR ART. A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987). Additionally, the MPEP §2114 R-1 clarifies that an apparatus claim is drawn to the structure of the device, not the function, by stating “[A]pparatus claims cover what a device is, not what a device does.” *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original).

Regarding claims 53 and 54, as best understood, because the time characteristics measuring device is connected to the real time clock, it inherently possesses a frequency meter and also an oscillator as it is notoriously well known in the art that a clock is in a continuous oscillation of cycles in order to keep track of the time that has passed.

### ***Response to Arguments***

Regarding the Applicant's assertion that the claims are no longer indefinite under 35 U.S.C §112, the Examiner respectfully disagrees. The Applicant claims that because all

variables have been removed the rejection has been overcome. However, there were a number of other issues at hand that have not been properly addressed nor has the Applicant pointed out support for them. The Examiner has reviewed the cited passage (page 16-18) noted by the Applicant but does not find any support to overcome the first paragraph rejections in the specification and therefore the Examiner maintains the rejections. If the Applicant wishes to again traverse the rejection, they must specifically point out by page and line number for each rejection proper support that explicitly discloses the elements.

Regarding the Applicant's argument that Fascenda et al. don't calculate the timing data in the exact manner the Applicant calculate the timing data, the Examiner maintains that the method of calculating timing data is known in the art as the properties of clocking and counting are notoriously well known and thus using one over another would be obvious to a skilled artisan, as discussed in the above rejection. The manner in which the time is recorded is a design choice with alternatives known in the art and are thus obvious. A skilled artisan is more than efficient in recognizing the number of ways in which timing data can be generated and read. It would be obvious to a skilled artisan that instead of comparing two recorded times that the times could be derived based on a frequency or period and then compared. The process is essentially the same as all time data has by its own nature a frequency and a period and adding the step of determining the time from this data is just a known feature in the art that was merely omitted by the Fascenda et al. disclosure. Fascenda et al. does not go into clocking details as to how the time is recorded and obtained. A skilled artisan though understands the intent of Fascenda et al. is to make sure the entry occurred before the event and to use a different known timing method would be obvious to a skilled artisan. Time is easily derived from period and frequency and using one means of establishing when an event was recorded over another would merely be representative of a design choice for one of ordinary skill in the art. The

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artisan would be motivated to use one over another based on their own wants, needs, and desires for their systems specifications and the decision to actually use a different known timing method over the method disclosed by Fascenda et al. would merely be representative of a design change by an artisan to best accommodate the timing needs for their own system and is merely representative an obvious change in choosing one known timing method over another.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Marks whose telephone number is (703)-305-7497. The examiner can normally be reached on Monday - Thursday (7:30AM - 5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, Jessica Harrison, Primary Examiner, can be reached on (703)-308-2217. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



cmm

May 27, 2004



JESSICA HARRISON  
PRIMARY EXAMINER